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EXAMINER

MUSSER, BARBARA J

ART UNIT

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1791

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/570,823 | Applicant(s) SCHMIDKONZ, PETER | |
| | Examiner BARBARA J. MUSSER | Art Unit 1791 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 3, 13, 14, 16, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, it is unclear what is meant by a “transversal slot” being discontinuous. As the transversal slot is the space between one perforation and the next, it is separate from other transversal slots. It is not clear if this language refers to the plurality of transversal slots being separate or if each transversal slot is itself somehow interrupted.

Regarding claim 3, it is unclear what is meant by this claim as it is unclear what is meant by cutting geometry and what is the longitudinal direction. Assuming the longitudinal direction is the cutting direction, it is unclear how the sides could be symmetrical since the blade alternates sides, causing the folded edge and thus the blade to not be symmetrical.

Regarding claim 13, it is unclear if this is an apparatus claim or a method claim as currently, it is a device which is dependent on a method. For the purposes of examination, this is considered to be an apparatus claim.

Regarding claim 14, it is unclear how a wave-like path can be formed by two parallel perforations lines as required by claim 13. It is unclear exactly what the

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traversal webs are, as the term appears to refer to the paper being cut, and it is unclear how this affects the structure of the knife. This term has no antecedent basis.

Regarding claim 16, it is unclear what limitations are required of the device as the claim is directed to the shape formed in the material worked upon.

Regarding claim 18, it is unclear how this further limits the device as it appears to be directed to two sheets having different perforations. It is unclear what is meant by "with the width of the transversal connecting line between the two perforations lines."

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4 and 10 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Yew(U.S. Publication 2003/0170094A1).

Yew discloses a method of bookbinding wherein sheets are perforated, folded, adhesive is applied, and the folded sheets are joined together into a book block.(Figure 1) The perforations form two interrupted parallel lines a small distance from one another and staggered relative to one another by the length of one tooth, i.e. one tooth

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cuts and then the other cuts.(Figure 2C) These perforations for a widened folding edge.(Figure 3A)

Regarding claim 2, the cuts are in a meander type(Figures 2A-2C) since the knife blade is similar to that which applicant describes as a meander type.(Figure 2, specification)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yew.

While Yew discloses the punched sheets are staggered relative to one another, it does not disclose they are staggered by one tooth pitch or half a tooth pitch, but indicates this is random. One in the art would appreciate that other variations known in the art such as a set variation such as half or a full tooth pitch would have been obvious since these are obvious alternatives to a random staggering.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yew as applied to claim 1 above, and further in view of Michalik(U.S. Patent 4,951,967).

The reference cited above does not disclose the cuts forming dovetails. Michalik discloses cutting sheets which are folded and bonded to form books wherein the

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transverse cut line can be at any angle.(Col. 4, ll. 22-23) It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the transverse cut lines of Yew at any angle such that dovetails could be formed since Michalik shows it is known to have a variety of angles in the cuts in the transverse direction.

8. Claims 6, 7, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yew as applied to claims 1 and 10 above, and further in view of Kang(EPO 0841649A2).

The reference cited above does not disclose the knife blade having transverse lines running from one blade to the blade on the opposite side which have an interruption so that a portion of the transverse line is not cut. Kang discloses a knife blade which has a continuous blade with the cutting edge moving from one side to the other with transverse sections therebetween which have an interruption so that the interrupted area is not cut.(Figure 5) It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the knife blade of Kang since performs a similar type of function. i.e. cutting most of the regions between two webs but not all resulting in the substitution of one known element for another to obtain predictable results.

9. Claims 11 and 13-15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yew as applied to claim 1 above, and further in view of Dalfiume(U.S. Patent 5,768,969).

Yew does not disclose the distance between the alternating knife blades are being variable. Dalfiume discloses a knife for forming sheets for a book having two

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separate knife blades with differing spacers which can be placed therebetween depending on the paper to be used.(Col. 2, ll. 15-29) It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a blade similar to that of Dalfume in Yew since this would allow the distance between the cutting surfaces to be varied dependent on the paper weight and density.(Col. 2, ll. 15-29)

10. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yew and Dalfume as applied to claim 13 above, and further in view of Kang.

The references cited above does not disclose the knife blade having transverse lines running from one blade to the blade on the opposite side resulting in a continuous cutting edge. Kang discloses a knife blade which has a continuous blade with the cutting edge moving from one side to the other with transverse sections therebetween which have an interruption so that the interrupted area is not cut.(Figure 5) It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the knife blade of Kang since performs a similar type of function. i.e. cutting most of the regions between two webs but not all resulting in the substitution of one known element for another to obtain predictable results.

Response to Arguments

11. Applicant's arguments filed 9/18/09 have been fully considered but they are not persuasive.

Regarding applicant's argument that Yew does not disclose the adhesive being between recesses of one perforation line and the other perforation line, examiner was under the impression this meant that the adhesive was located between the two

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perforation lines in the region the fold was located. Yew discloses coating the flaps, which are the areas between the perforation lines, i.e. the space between one line and the next where the fold is located. If applicant meant something different, then the claim should be corrected.

Regarding applicant's argument that Yew assembles the sheets and then folds, the reference states no such thing. Aside from the fact this would make the outermost sheets have a substantially larger area in the spine since the outer sheets would be folded around the inner sheets resulting in a huge waste of paper, the reference discloses the method comprises perforating the signatures, bending them(i.e. folding), compiling them into a book, and applying adhesive to the signatures([0009]-[0015]). While applicant's claim does suggest applying the adhesive occurs before the assembly by the placement of the steps in the claim(which applicant did not even argue), the claim does not require the steps occur in this order and thus can occur in any order.

Regarding applicant's argument that the flaps of Yew are passed through adhesive and mainly adhere the sheets together, since the function of applicant's flaps is also to receive adhesive and adhere the sheets together, examiner is unclear as to what applicant is arguing.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BARBARA J. MUSSER whose telephone number is (571)272-1222. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571)-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BJM

/B. J. M./

Examiner, Art Unit 1791

/Richard Crispino/

Supervisory Patent Examiner, Art Unit 1791